

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 2534997Y (CN '997; translation provided, referred to herein) in view of Judet et al. (U.S. Patent 5,591,168, cited in a previous office action). CN '997 teaches an artificial hip joint (seen in Fig. 7) comprising a center bone screw 14 including an external thread at its periphery and another end of center bone screw being exposed from a femur neck (seen in Fig. 7) and a femur neck protecting device 10, being coupled to an end of the center bone screw (seen in Fig. 7), for protecting said femur neck, said femur neck protecting device comprises a hollow sleeve 11, and said hollow sleeve includes an externally extended and slightly curved flange 12 disposed at an end of the periphery of said hollow sleeve and an inwardly withdrawn neck section 13 protruded from another end of said hollow sleeve, such that said neck section is coupled precisely (Figure 10) to said center bone screw 14, and said sleeve includes at least one hole 15 disposed at said flange.

CN '997 does not teach an enhancing bone plate or an enhancing bone screw, but does include a bone screw and fasteners 40 for securing the device to the femur.

Judet et al. teaches an implant for treating pathology of the femur that includes two bone screws (3 and 3e) and an enhancing bone plate 1a, which includes an opening hole (inner bore of 1c) and more than one hole for passing a fixing element 1b. The bone screw 3e includes a head section having an area larger the area of said opening hole (seen in Fig. 3). The bone plate supports, or stabilizes, the two screws (Abstract; naturally follows from the fracture being stabilized and being attached to the bone screw 3) and the screw 3e is used to attach the screw 3 to the bone plate (col. 2, ll. 54-60). *Note:* the two bone screws are fixed to each other using an internal screw thread on one and an external screw thread on the other. It would have been obvious to someone of ordinary skill in the art at the time of the invention to add the bone plate to the invention of CN '997 in order to better stabilize the element attached to a bone screw, namely the artificial joint. It also would have been obvious to use an additional screw to fix the plate of Judet et al. to the center bone screw of CN '997 and it would have been within the ordinary skill of the art to vary which screw has the internal thread or external thread. *Note:* applicant places no criticality on where the screw thread is placed, internally or externally, in the screws of the device. Additionally, it has been held that the mere reversal of parts to be an obvious expedient. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955).

Concerning claim 2, the plate of Judet et al. includes holes 1b which allow fixation thereof on the femur (col. 2, ll. 3-4). A screw would have been an obvious fixing element in the art.

Response to Arguments

3. Applicant's arguments filed 14 November 2007 have been fully considered but they are not persuasive. CN 2534997Y (CN '997) has a publication date of 12 February 2003 which is more than a year before the PCT date of 15 March 2004 of the instant application, which would be the filing date of the instant application in the U.S., and therefore qualifies as prior art under 102(b). Therefore the disclosure of CN '997 acts as a statutory bar even if the disclosure is by the same inventor of the instant application. Also, the disclosure of CN '997 teaches the device for protecting the femoral head (see Title). It would have been within the ordinary skill of the art to improve a device to provide more protection for vulnerable bone structure. Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have *suggested* to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. SIGLER whose telephone number is (571)270-3647. The examiner can normally be reached on Monday through Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Yao can be reached on (571) 272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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